

Docket No. RSW920000147US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: LaTondra A. Murray

APPLICATION NO. 09/855,109

FILED: May 14, 2001

Examiner: R. Pitaro

CASE NO. RSW920000147US1

Group Art Unit: 2174

TITLE: METHOD, SYSTEM, AND COMPUTER-PROGRAM PRODUCT
FOR THE CUSTOMIZATION OF DROP-DOWN LIST BOXES
USING "HOT LISTS"

CERTIFICATE OF MAILING

I hereby certify that this correspondence, along with any paper indicated as being enclosed, are being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to: MAIL STOP AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 3, 2006.

August 3, 2006
Date


Barbara G. Makariou

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In response to the final Office Action of May 3, 2006 regarding the above-identified application, Applicant hereby requests review of the final rejection. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

REASONS FOR REQUEST

Applicant has filed a Notice of Appeal in the above-identified application. Applicant further requests a pre-appeal review of the examiners rejection of the above-identified application as Applicant believes the Examiner has failed to identify the presence of essential elements required to establish a *prima facie* rejection.

The Examiner Has Not Established a *Prima Facie* Case of Anticipation

As outlined in previous responses from the Applicant, such as the Reply mailed February 1, 2006, differences between the present claimed invention and the prior art of record have been discussed extensively. However, Applicant believes that the Examiner has failed to disclose where the prior art of record teaches a particular limitation of the claimed invention.

The present claimed invention includes the feature of allowing a user access a “hot list” used in connection with a drop down list such as those commonly used on web pages. This hot list is a subset of items that are present in the complete listing of the drop down list. For example, if the drop down list is a listing of the United States, a user may define the hot list to be “New York, Pennsylvania, Virginia”. Then by manipulating the selection button for the list in a second manner (e.g., right clicking as shown in Figure 5) only the hot list is displayed, making selection of one of the items contained on the hot list much quicker.

Specifically, Claim 1 states:

“a hot list box displaying a subset of items from said selection set of items when said selection button is manipulated in a second manner, wherein the items to be included in said subset of items are manually selectable by a user of said GUI.”

Each additional independent claim (9, 11, and 13) includes a variation of this limitation. This limitation is beneficial in the fact that it allows users to create custom menus that contain the items that will be of interest to them and quickly access these menus by manipulating a common selection button in a second manner. This subset, or hot list feature, defines the present claimed invention as novel over the prior art, including Ishitaki.

Ishitaki generally focuses on how pop-up menus are arranged and triggered to appear. In a portion repeatedly cited by the Examiner (col. 5, lines 3-34), Ishitaki only discusses the triggering of the menus, detailing how the number of successive clicks of a mouse button, or how the duration of a click of a mouse button is used as a determination factor in deciding which pop-up menu is generated. Ishitaki, however, fails to teach or suggest a user having the ability to determine which selectable items are included in a subset of a listing of items being display as is claimed by the present invention. The user is only given the option to add/delete and re-order the items in the menu, not manually create a hot list menu that represents a subset of the selectable items on the menu. Col. 9, lines 57-65 of Ishitaki state:

“The interface **1540** (FIG. 12B) is used to re-order the items of a selected menu. In other words, interface **1540** enables the user to modify the sequence in which items in each menu are displayed. Window **1560** reflects the current (default) order of the menu items and window **1570** reflects the newly defined order. The user re-orders the items using arrows **1581**, **1582**, and either saves the order by clicking on the set button **1591** or cancels using cancel button **1592**.”

Ishitaki allows the user to re-order the items presented in the menu, but not add a selectable item to the pop-up menu. Additionally, Ishitaki does not allow the user to manipulate a selection button in a second manner to produce a subset of selectable choices from a larger set.

Inasmuch as Ishitaki does not teach or suggest this feature of allowing a user to manually add a selectable item to a menu, and since this feature is specifically claimed in independent Claims 1, 9, 11 and 13, it is submitted that the rejections of Claims 1, 9, 11 and 13 under 35 U.S.C. §102 based upon Ishitaki is inappropriate. Accordingly, each of the independent claims, and all claims depending therefrom, patentably define over Ishitaki and are in condition for allowance.

Conclusion

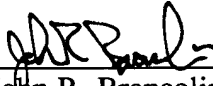
The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 09-0461.

Respectfully submitted,

August 3, 2006

Date



John R. Brancolini
Registration No. 57,218

SYNNESTVEDT & LECHNER LLP
2600 ARAMARK Tower
1101 Market Street
Philadelphia, PA 19107
Telephone: (215) 923-4466
Facsimile: (215) 923-2189